

Remarks

Claims 1-35 are pending in the application. All claims stand rejected. By this paper, claims 1, 6-8, 10-14, 17-19, 26, 27, and 32-34 have been amended. Reconsideration of all pending claims herein is respectfully requested.

Claims 17-19 and 27 were objected to because of various typographical errors. These claims have been amended per the Examiner's suggestions.

Claims 1-7, 10-17, 19-23 and 26-33 were rejected under 35 U.S.C. 102(e) as being anticipated by Darbee et al. ("Darbee"). Claims 8, 18, 24, and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Klosterman et al. ("Klosterman"). Claims 9, 25, and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Saitoh et al. ("Saitoh").

As amended, claim 1 recites a remote control device for scheduling television recordings without interfering with a television program being currently watched on a television, comprising:

- a wireless receiver for receiving television program schedule information from an interactive television system;

- a display device for displaying the television program schedule information;

- an input device for receiving a user selection of a television program from the displayed television program schedule information; and

- a wireless transmitter for transmitting an indication of the selected television program to the interactive television system to schedule recording of the selected television program by a recording device.

These claimed features allow a user to easily program a recording device (such as a VCR or DVR) without having to know either the channel or the start time of a television program to be recorded, and without obscuring even a portion of the

television screen, allowing other family members to continue to watch television without interruption.

As the Examiner admits, Darbee does not disclose or suggest television recording. Indeed, Darbee's remote control is limited to changing channels on the television, as well as displaying certain news and weather information. The addition of Klosterman, however, does not cure the deficiencies of Darbee. Klosterman only displays his program guide on the main television, inevitably obscuring part of the television program being watched. Accordingly, Klosterman actually teaches away from the claimed remote control for scheduling television recordings "without interfering with a television program being currently watched on a television."

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03. In this case, the claimed limitation of using a display device on a remote control to schedule recordings without interfering with television viewing is not taught or suggested by the cited references. Klosterman only uses the main television screen. Darbee only uses the display screen in his remote control for changing channels and viewing weather/news information. Neither reference, however, discloses using another display screen (on a remote or otherwise) to schedule recordings in order to avoid interference with a television program being currently watched, as required by amended claim 1. To insert such a limitation would be to rely on hindsight reconstruction based on the applicant's own teachings.

Furthermore, Darbee does not transmit "an indication of the selected television program" (as opposed to a channel) as required by amended claim 1. Darbee's

remote control transmits "direct tune" commands to the television to cause the television to tune to a particular channel. Col. 10, lines 2-11. A channel does not identify a particular television program. For example, Darbee does not disclose or suggest transmitting "an indication of at least a channel and a start time" (which would indicate a particular television program) or a "VCR Plus code" (which would likewise indicate a program) as recited in amended claims 6 and 7, respectively.

The applicant respectfully submits that the foregoing limitations are not taught or suggested by either reference, and that a prima facie case of obviousness cannot be established with these references.

In addition, Darbee and Klosterman provide no motivation to combine the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Even if all the elements of a claim are disclosed in the various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

Darbee discloses channel changing in contrast to recording. Indeed, Darbee is completely silent about recording. Klosterman is silent about using a separate display for a program guide, and specifically teaches the use of the main television for displaying the program guide. There is simply no impetus to combine the channel-changing function of Darbee with the scheduling function of Klosterman.

Finally, even if the references were combined, the combination would not result in the claimed invention. Darbee's remote control is used for channel changing. Klosterman discloses scheduling based on a program guide displayed on the television screen. At best, a combination of Darbee and Klosterman, without hindsight reconstruction based on the applicant's own teachings, would result in a system in which a user could change channels using the remote control, but would still be required to schedule recordings on the main television screen. However, such a combination would "interfere with a television program being currently watched on a television," contrary to claim 1.

The addition of Saitoh does not cure the deficiencies of Darbee and Klosterman, but merely discloses a remote control device with a touch-sensitive display screen.

The applicant respectfully submits, therefore, that claim 1, as amended, is patentably distinct over the cited references, alone or in combination. Claims 2-9 depend directly or indirectly from claim 1 and are likewise believed to be patentably distinct for at least the same reasons. Independent claim 26 has been amended to include similar limitations and is also believed to be patentably distinct along with dependent claims 27-35.

Claim 5 recites that the "electronic programming guide comprises a plurality of rows corresponding to channels and a plurality of columns corresponding to time slots." Darbee, however, only displays a single column for a single time slot. See, e.g., FIG. 5A. Darbee specifically states that "[e]ach screen preferably displays information for one half-hour of the 24-hour period." Col. 9, lines 41-43. Thus, no

screen in Darbee displays a plurality of columns for a plurality of time slots, as claimed.

Amended claim 6 recites that the indication of the selected television program (transmitted by the remote control) comprises "an indication of at least a channel and a start time." However, Darbee only discloses transmission of "direct tune" commands to the television, which is essentially a channel number. Col. 10, lines 2-11. Klosterman has no need to transmit "an indication of at least a channel and a start time" from a remote control to an interactive television system, because a user selects a program to be recorded directly from the program guide displayed on the television screen. Accordingly, amended claim 6 is patentably distinct over the cited references.

Claim 7 recites that the indication of the selected television program comprises a "VCR Plus" code. Neither reference discloses or suggests transmission of "VCR Plus codes" or any other code that indicates a particular television program, as opposed to a channel. Accordingly, claim 7 is believed to be patentably distinct.

Claim 8 recites the further limitation that "the wireless receiver is to receive a secondary television signal from the interactive television system for display on the display device" on the remote control. None of the cited references, alone or in combination, disclose the displaying of a secondary television signal on a remote control so that a user may watch two television programs simultaneously, one on the main television screen and the other on the remote control.

Independent claim 10 and dependent claim 34 have been amended to include a similar limitation. Accordingly, the applicant respectfully submits that claim 10

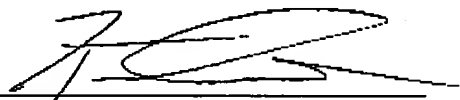
(along with dependent claims 11-25) and claim 34, as amended, are patentably distinct over the cited references, alone or in combination.

In view of the foregoing, claims 1-35, as amended, are believed to be patentably distinct. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Digeo, Inc.

By


Kory D. Christensen
Registration No. 43,548

STOEL RIVES LLP
One Utah Center Suite 1100
201 S Main Street
Salt Lake City, UT 84111-4904
Telephone: (801) 328-3131
Facsimile: (801) 578-6999